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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

MUMTAZ SHAH

SERIAL NO.: 09/403,796

ART UNIT: 3724

FILED: OCTOBER 25, 1999

EXAMINER: CHARLES GOODMAN

TITLE: CUTTING SHEET MATERIAL

AMENDED APPEAL BRIEF

On October 1, 2002, in response to the final Office Action, dated March 26, 2002, Applicant, Appellant herein, timely appealed (including a 37 C.F.R. §1.8 first-class certificate of mailing, dated September 25, 2002, and requisite three-month extension of time under 37 C.F.R. §1.136(a)) from the final rejection of Claims 20-24.

On January 14, 2003, the Examiner issued a "Notification of Non-Compliance," apparently, for the reason that the Summary of the Invention, which does refer the drawing figures by reference numeral, does not also refer to the textual Specification by page and line number. This Amended Appeal Brief includes reference to the textual Specification as part of the Summary of the Invention, but is otherwise substan-

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as First Class Mail addressed to: Hon. Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231.

Edwin D. Schindler

Edwin D. Schindler, Reg. No. 31,459

February 13, 2003
Date

tively identical to Appellant's original Appeal Brief, filed October 31, 2002.

What follows is, therefore, Appellant's Amended Appeal Brief, filed in triplicate. The requisite fee for filing the Appeal Brief, as set forth in 37 C.F.R. §1.17(f), was previously paid on October 31, 2002. No additional fee is due for this Amended Appeal Brief.

I. Real Party in Interest

(37 C.F.R. §1.92(c)(1))

The real-party-in-interest is the inventor, Mumtaz Shah. The instant patent application has not been assigned.

II. Related Appeals and Interferences

(37 C.F.R. §1.92(c)(2))

There are no related appeals or interferences pending.

III. Status of Claims

(37 C.F.R. §1.92(c)(3))

The above-identified patent application was filed into the U.S. National Phase, pursuant to 35 U.S.C. §371, on October 25, 1999, with Claims 6-19, as entered via the concurrently-filed Preliminary Amendment, which cancelled Claims 1-5, as entered during the P.C.T. Chapter II Preliminary Examination of P.C.T. Application No. PCT/GB98/01211, filed April 24, 1998, which claims foreign priority under 35 U.S.C.

§119 on the basis of United Kingdom Patent Application No. 9708327.3, filed April 25, 1997. Claims 6 and 13 were presented in independent form.

On October 2, 2000, the Examiner issued a first Office Action rejecting Claims 6-19 over the prior art made of record.

On January 2, 2001, Appellant filed his "Amendment in Response to the First Office Action," pursuant to 37 C.F.R. §1.8. As it concerns the issues pertaining to this appeal, in his reply to the first Office Action Appellant cancelled Claims 6-19 and substituted therefor new Claims 20-24, with Claim 20 being the singular independent claim pending in the application.

On March 28, 2001, the Examiner issued a second, and final, Office Action, in which independent Claim 20 was rejected as being anticipated, pursuant to 35 U.S.C. §102(b), by Chuang, U.S. Patent No. 4,960,022. Independent Claim 20 was also separately rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Li, U.S. Patent No. 5,638,603, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569. Dependent Claims 21-24 were also rejected in the final Office Action over the prior art of record.

On June 27, 2001, Appellant filed a Continued Prosecution Application ("CPA") and response to the final Office

Action, dated March 28, 2001. Appellant entered the following amendment to independent Claim 20 (and Claims 21-24 via dependency):

20. (Amended) Apparatus for cutting sheet material, comprising:

a [freely movable] unit capable of freely moving in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;

an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material;

a cutting blade secured in said upper and lower parts, and extending across said gap, said sheet support surface and said upper surface extending to either side of said cutting blade; and,

pressure means mounted on said upper part in said gap for bearing on the piece of sheet material supported by said lower part adjacent to said cutting blade, so that the piece of sheet material is able to be inserted between said pressure means and said sheet support surface for tensioning the piece of sheet material in proximity of said cutting blade.

On July 11, 2001, the Examiner issued a third, non-final, Office Action maintaining the prior art rejections of Claims 20-24, as set forth in the final Office Action, dated March 28, 2001. The rejection of the third Office Action

dealt with the patentable weight to be accorded the phrase "a unit capable of freely moving in both linear and non-linear paths . . . , " recited in the first sub-paragraph of independent Claim 20.

On December 11, 2001, Appellant filed his "Amendment in Response to the Third Office Action," pursuant to 37 C.F.R. §1.8 (along with a petition for a two-month extension of time, pursuant to 37 C.F.R. §1.136(a), and requisite extension fee), which was not formally received by, and filed in, the Patent and Trademark Office until January 8, 2002, due to the need for anthrax decontamination. Appellant's response entered the following amendment to independent Claim 20 (and Claims 21-24 via dependency):

20. (Twice Amended) Apparatus for cutting sheet material, comprising:

a unit [capable of freely moving] freely movable in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;

an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material;

a cutting blade secured in said upper and lower parts, and extending across said gap, said sheet support surface and said upper surface extending to either side of said cutting blade; and,

pressure means mounted on said upper part in said gap for bearing on the piece of sheet material supported by said lower part adjacent to said cutting blade, so that the piece of sheet material is able to be inserted between said pressure means and said sheet support surface for tensioning the piece of sheet material in proximity of said cutting blade.

On March 26, 2002, the Examiner issued a fourth, and final Office Action, maintaining the prior art rejection of Claims 20-24 for substantially (if not identically) the reasons of record.

Appellant did not file a Response to the final Office Action, dated March 26, 2002, pursuant to 37 C.F.R. §1.116.

Therefore, the status of the claims on appeal is:

Claims allowed: None

Claims objected to: None

Claims rejected: Claims 20-24

Claims cancelled: Claims 1-19

IV. Status of Amendments

(37 C.F.R. §1.192(c)(4))

No amendments after final Action were filed. The status of the claims is unchanged from that indicated in the final Office Action, dated March 26, 2002. A complete copy of the claims on appeal, as required pursuant to 37 C.F.R.

§1.192(c)(9), accompanies this Appeal Brief.

V. Summary of Invention

(37 C.F.R. §1.192(c)(5))

Appellant's invention provides an apparatus for cutting sheet material, which can be used to cut along other than a straight line, and which, preferably, may be used freely (i.e., is "freely movable" without restriction in both linear and non-linear directions) over the entire area of the sheet of material. (See, Specification at Page 1, lines 18-21) Prior to the present invention, conventional cutting apparatus could only be utilized for cutting sheets to pre-determined sizes and in a straight line. (See, Specification at Page 1, lines 12-17) For cutting sheet material, whether it be paper or cloth, etc., in other than a straight line, the craftsman would be required to use scissors or shears for a free-hand, non-linear cutting procedure.

The foregoing and related objects are achieved by the apparatus of the present invention for cutting sheet material (10), which includes a unit (11, 12) freely movable in both linear and non-linear paths (see, Specification at Page 3, lines 14-19), which has a lower part (11) defining a sheet support surface for placement of a piece of sheet material, and an upper part (12) defining an upper surface and disposed above said lower part with a gap (13) existing between said upper part (12) and said lower part (11) for

receiving the piece of sheet material (23). (See, Specification at Page 4, lines 12-17) A cutting blade (14) is secured in the upper (12) and lower parts (11), and extends across said gap (13). (See, Specification at Page 5, lines 5-13) The sheet support surface (16) and the upper surface (12) extend to either side of the cutting blade (14). (See, Specification at Page 5, lines 5-13) Pressure means (e.g., wheel (22) is mounted on the upper part in the gap for bearing on the piece of sheet material (23) supported by the lower part (11) adjacent to the cutting blade (14) (see, Specification at Page 5, line 19 - Page 6, line 1), so that the piece of sheet material (23) is able to be inserted between the pressure means (23) and the sheet support surface (16) for tensioning the piece of sheet material (23) in the vicinity of the cutting blade (14). (See, Specification at Page 5, lines 5-10)

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel and efficient apparatus for cutting sheet material in both linear and non-linear paths either disclosed or suggested.

VI. Issues

(37 C.F.R. §1.192(c)(6))

The issues presented in this Appeal are as follows:

A. Claims 20-22 have been rejected as being antici-

pated, pursuant to 35 U.S.C. §102(b), by Chuang, U.S. Patent No. 4,960,022;

B. Claim 23 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Chuang, taken in view of Shah, United Kingdom Patent Application No. 2,223,976;

C. Claim 24 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Chuang, taken in view of Li, U.S. Patent No. 5,638,603;

D. Claims 20-22 and 24 have been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Li, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569; and,

E. Claim 23 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Campbell, Jr., as applied to Claims 20-22 and 24, taken in view of Shah.

Claims 1-19 have been cancelled.

VII. Grouping of Claims

(37 C.F.R. §1.192(c)(7))

Claim 20 is the single independent claim pending in the above-identified patent application. The following anticipation and obviousness rejections will be argued separately in this Appeal Brief:

1. Claims 20-22 have been rejected as being antici-

pated, pursuant to 35 U.S.C. §102(b), by Chuang, U.S. Patent No. 4,960,022; and,

2. Claim 23 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Chuang, taken in view of Shah, United Kingdom Patent Application No. 2,223,976.

The obviousness rejections issued against dependent Claims 23 and 24, which are separate from the prior art rejections issued against independent Claim 20, will not be separately argued, and the patentability of these dependent claims will be allowed to stand or fall on the basis of whether independent Claim 20 is patentable.

VIII. Argument

(37 C.F.R. §1.192(c)(8))

A. The Legal Scope of Appellant's Independent Claim 20

In the final Office Action, dated March 26, 2002, the Examiner declined to give the phrase "freely movable," which described the potential movement for cutting as being in both linear and non-linear directions, patentable weight. The Examiner's refusal to provide such terminology its proper patentable weight is without legal merit and would appear to be determinative of whether the prior art rejections of record should be sustained or reversed.

In the final Office Action, dated March 26, 2002, the

Examiner has cited to Ex parte Masham, 2 USPQ2d 1647 (PTO Bd. of Pat. App. & Inter. 1987), for the legal proposition that

" . . . a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations."

Final Office Action at p. 2, para. 3; at 4, para. 7; at 6, para. 9 (3/26/02)

While the Examiner has correctly paraphrased the legal holding in Masham, the Examiner has improperly applied its holding to the structural limitation recited by the phrase "freely movable" in the first sub-paragraph of pending independent Claim 20.

Referring to Masham, the precise holding of the Board was presented as follows:

"[A] recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from the prior art apparatus satisfying the structural limitation of that claimed.

Ex parte Masham, 2 USPQ2d at 1648 (emphasis in original).

Had Appellant been seeking to differentiate independent Claim 20 over the applied prior art on the ground that the presently claimed invention performs work on "sheet material," while the prior art was intended to function upon some other material, then the ruling of Masham would be applicable to the rejections of record on this appeal, absent some structural

distinction over the prior art. Appellant, however, is arguing that the phraseology "freely movable" in the first subparagraph of Claim 20 imposes a structural limitation on the claimed invention, independently of the material upon which the "unit" in Claim 20 is intended to function!

More particularly, the first sub-paragraph of independent Claim 20 reads as follows:

"a unit freely movable in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;"

Emphasis added.

The term "freely movable" clearly describes a structural feature of the "unit" of Claim 20, in that the "unit" is capable of freely moving in both linear and non-linear paths. A "unit" which was structurally incapable of both linear and non-linear path movement, perhaps because it was fixed in a linear path only, as is common in the prior art, would be structurally different from the "unit" recited in Appellant's Claim 20. The free movability of the "unit" of Claim 20 is not described or claimed with any particular reference to the sheet material upon which the claimed invention is intended to function. Consequently, aside from standing for the broad proposition that the mere recitation of an intended use for a claimed apparatus is insufficient for reciting a structural limitation on an apparatus claim, which Appellant does not dispute, Ex parte Masham, supra, is simply not relevant to a

determination of whether "freely movable" in Claim 20 properly recites a structural limitation on the "unit" upon which Appellant may justifiably rely upon for avoiding the prior art.

To recite in a patent claim that an article or apparatus is "capable of" performing a function is to recite a structural limitation in that claim, such as the recited structure may - as opposed to "may not" - perform the given function. A structure unable to, or "incapable of," performing the recited function cannot be structurally the same as one so capable. Stated differently, a recitation that states what an article or apparatus can do is a limitation on the structure recited in the claim and is properly accorded patentable weight under the law.

More recently, in *C.R. Bard Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 48 USPQ2d 1225, 1229-1230 (Fed. Cir. 1998), the Federal Circuit construed the scope of a claim drawn to a biopsy needle, which included the term "freely slidable," as part of the second sub-paragraph of the body of the independent claim under consideration. The term "freely slidable" was used in the clause "a second needle extending through said hollow first needle and freely slidable therewithin." The limitation under consideration did not include "means for" claim language, which would not have been appropriate in such a claim (since an additional structure for such "means"

would have been implied, and did not appear to exist or be required.)

In C.R. Bard, one party argued that the term "freely slidable" constituted a claim limitation calling for a particular element (i.e., the "second needle") to be "freely slidable" in both back and forth directions. The opposing party argued that "freely slidable" was a limitation for permitting the second needle to be "freely slidable" in just a forward direction. The Federal Circuit in C.R. Bard ruled that the patent claim before it included the claim limitation that the given element in question had to be "freely slidable" in both directions, which was consistent with the specification and allowed the claim to be patentable over the prior art. The Federal Circuit clearly treated - and found! - that the term "freely slidable" constituted a structural limitation in the claim under review in C.R. Bard.

The phrase "freely movable" in Claim 20 is clearly entitled to patentable weight as a structural limitation in Appellant's claims for the identical reason that "freely slidable" was accorded patentable weight in the claims before the Federal Circuit in C.R. Bard.

In Zeller Plastik, Koehn, Grabne & Co. v. Joyce Molding Corp., 698 F.Supp. 1204, 10 USPQ2d 1081, 1091-1092, 1096 (D.N.J. 1988), a district court granted a preliminary injunction against an alleged infringer of a patent containing

claims which used the phrase "freely movable."

Appellant has been unable to locate any court case or decision of the Board of Patent Appeals & Interferences which would suggest, or logically permit, the phrase "freely movable" to be denied patentable weight, particularly in light of the Federal Circuit's ruling in C.R. Bard according patentable weight to the term "freely slidable."

Consequently, the Board is requested to properly construe Appellant's claims whereby the phrase "freely movable" recites a structural limitation on the "unit" recited in the first sub-paragraph of independent Claim 20, and to then evaluate the Examiner's prior art rejections in a light which accords patentable weight to this limitation on the claims.

*B. The 35 U.S.C. §102(b) Anticipation Rejection
of Claims 20-22 by Chuang*

In the final Office Action, dated March 26, 2002, the Examiner has rejected Claims 20-22 as being anticipated, pursuant to 35 U.S.C. §102(b), by Chuang, U.S. Patent No. 4,960,022. According to the Examiner, Chuang discloses a plastic film cutter comprising all of the elements recited in the enumerated claims of the rejection, including a freely movable unit that is freely movable along a guide rail (307). The Examiner has expressly refused to accord the phrase "capable of freely moving . . . " any patentable weight. Finally, the Examiner has contended that "Chuang's unit is freely

movable when used without the supporting board since there is nothing in the claims that precludes this reading of Chuang."

In reply to the Examiner's anticipation rejection applying Chuang and taking into account the Examiner's rebuttal comments, pending independent Claim 20 specifies that the "unit" of the invention is "freely movable in both linear and non-linear paths." Chuang discloses a plastic film, rail-guided cutter which is clearly not capable of movement in both linear and non-linear paths, as Appellant claims. The rail (307) in Chuang is clearly illustrated (e.g., FIG. 3C) as being linear and nothing in either the drawing figures or the textual disclosure of Chuang would suggest use of a rail that was non-linear, nor does Chuang recognize the benefit of a freely moving unit which is also capable of non-linear path movement. The use of a linear rail, in fact, it submitted to clearly teach away from the concept of a cutting unit following a non-linear path for non-linear cutting.

In the final Office Action, dated March 26, 2002, the Examiner suggests that "Chuang's unit is freely movable when used without the supporting board since there is nothing in the claims that precludes this reading of Chuang." Appellant is unsure of which "claims" the Examiner is referring to, Appellant's or Chuang's, however, this uncertainty does not appear to be relevant: Referring to Chuang, Col. 2, lines 44-47, the applied citation states that:

"As shown in FIG. 3A, the main part of the present invention is a supporting board 300, upon the two sides of which, there are [sic] a plurality of clamping plates 302, 303, 304, 305, 306." (Emphasis added)

Inasmuch as the "main part" of the Chuang apparatus is taught to be the "supporting board," to use Chuang without the supporting board, as suggested by the Examiner, is a contradiction of the express teachings of the applied reference and a form of impermissible hindsight application of the prior art.

Assuming, arguendo, that Chuang could be used without a "supporting board," since the supporting board is recited in dependent Claim 3 of Chuang, but not recited in Claim 1, the Examiner has presented a classic "straw man" argument: The supporting board (300) in Chuang may be "fixedly" attached to the furrow (307) of the Chuang apparatus, as best illustrated in FIG. 3A of Chuang. The furrow (307), itself, which is recited in Claim 1 of Chuang is shown to be linear. Consequently, whether the Chuang apparatus is used with, or without, the supporting board (300), is not relevant, contrary to the Examiner's suggestion, since the furrow (307) is linear, thereby ensuring a linear cut of material with the Chuang apparatus.

In light of the recitation in Appellant's claims that the unit of the present invention is "freely movable in both linear and non-linear paths," which should properly be accorded patentable weight, Appellant respectfully submits that the Examiner's 35 U.S.C. §102(b) anticipation rejection

of Claims 20-22, which applied Chuang, has been overcome and should now be reversed by the Board.

C. The 35 U.S.C. §103(a) Obviousness Rejection of Claims 20-22 and 24 over Li, Taken In View of Campbell, Jr.

Separately, in the final Office Action, the Examiner had also rejected Claims 20-22 and 24 as being obvious, pursuant to 35 U.S.C. §103(a), over Li, U.S. Patent No. 5,638,603, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569. In this obviousness rejection, it is the Examiner's contention that the primary reference of Li discloses Applicant's invention, substantially as claimed, including upper and lower parts, a gap therebetween, a cutting blade and a blade holder. The Examiner, however, does concede that the Li cutter fails to include means for exerting pressure, as is included in Appellant's claimed invention. The Examiner has, therefore, secondarily-applied Campbell, Jr. for its contended teaching of a cutter having means for exerting pressure via a roller (17) disposed immediately in front of a cutting blade (14) for the purpose of placing the sheet material to be cut under tension. The Examiner has, therefore, concluded that it would have been obvious to have provided the device of Li with the means for exerting pressure, as taught by Campbell, Jr., in order to facilitate an enhanced tensioning of the sheet material during cutting. The Examiner has also stated the opinion (which Applicant strongly contends is incorrect) that a claim recitation of an element "capable of"

performing a function is not a limitation on the structure recited in that particular claim. This, of course, references back to the difference of opinion between Appellant and the Examiner as to the patentable weight which should be accorded to the term "freely movable" in the first sub-paragraph of independent Claim 20.

Finally, the Examiner has contended that "Li's unit is freely movable in a plurality of directions since there is nothing in Li's teachings that is contrary to this reading of Li." Appellant will explain that this is not the case in Li.

In reply to the Examiner's obviousness rejection applying Li, taken in view of Campbell, Jr., Li is intended for cutting wrapping off of a roll in a manner which is parallel to an edge thereof. The Abstract of Li makes clear that when the holding part (14) of the wrappage cutter disclosed therein "is pushed forward against a paper to be cut, the paper can be easily and straight cut [sic] in a quick and safe manner." (Li, Abstract, lines 5-7) The "Background of the Invention" in Li further clarifies that the article therein is intended to replace the need for using a ruler to achieve a straight cut of wrapping paper, which is further confirmed in the detailed description of Li (Col. 2, lines 62-64), which states that "[n]o ruler is needed in cutting the wrapper paper 3 while the paper can be cut straight and smooth." Further, the two "side parts" in Li, designated by reference

numeral "11" therein, make clear that a straight, or linear, cut is all that is intended, and would appear all that is possible, with the cutting device disclosed in Li.

The secondary reference of Campbell, Jr. discloses a letter opener, which invariably cuts open letters, not sheets of paper in a straight, or linear, manner because: (a) the letter itself is invariably linear in form and (b) the groove through which the edge of the envelope to be cut open passes through forces a straight, or linear, cut. (Campbell, Jr., FIG. 2, reference numerals "5" and "6")

The present invention, as claimed, expressly recites the unit is "freely movable" in both linear and non-linear paths," which is clearly impossible for an envelope to so move through the opener in Campbell, Jr.

Concerning the Examiner's contention that "Li's unit is freely movable in a plurality of directions since there is nothing in Li's teachings that is contrary to this reading of Li" (Final Office Action, at 4, para. 7 (3/26/02)), the Li citation expressly teaches that the wrappage cutter disclosed therein is to provide a "straight cut" (see, Li, Abstract), and is shown in all six drawing figures of Li as being linear in construction. The Examiner's contention that the cutter in Li may be "freely movable in a plurality of directions" is not the same as stating that the Li cutter is either capable of, or even intended to, follow a non-linear path. Literally,

each "direction" of the "plurality of directions," suggested by the Examiner can be linear. Linearity does not rule out a "plurality of directions." Non-linearity, however, does rule out the "straight cut" created by the Li wrapper cutter.

Because Li and Campbell, Jr. both disclose articles intended for cutting only in a linear path, and neither reference considered separately or in combination with one another suggests any manner of a non-linear cutting path (and, in fact, the construction of each would rule out a non-linear cutting path), Appellant respectfully submits that the presently claimed invention cannot reasonably be viewed as being obvious over the proposed combination of art.

Further, in the third Office Action, dated July 11, 2002, the Examiner's responded to Appellant's earlier contention that the letter opener in Campbell, Jr., is not analogous art to the sheet cutter of the presently claimed invention and, as a matter of record in the file wrapper, must state that Appellant cannot agree with the Examiner's analysis, which has been incorporated by reference into the final Office Action, dated March 26, 2002, at Page 7, para. 9.¹.

In the third Office Action, dated July 11, 2002 (at 7),

1. The Examiner's comment that "Applicant's basic argument that Campbell, Jr. is not analogous art, this argument lacks merit," is a dismissive and inappropriate response to Appellant's bona-fide contentions of fact and law, and should be recognized by the Board as a tacit concession by the Examiner as to the validity of Appellant's position.

the Examiner incorrectly contended that "[i]t is irrelevant to what degree Campbell Jr. has with respect to Applicant's disclosed invention, since it is the claims that are at issue, not the disclosed invention." The Examiner's statement of the law concerning what shall be determined to be non-analogous art is flawed, and remains unrebutted in the final Office Action.

It is Appellant's disclosure that defines the technical field of the invention, including the intended use of the invention, not simply the claims. While, an intended use for an apparatus is entitled to no "patentable weight" on the issue of anticipation, the same is not the case where an applicant's claims have been rejected solely on the ground of obviousness over the prior art. See, United States v. Adams, 383 U.S. 39, 148 USPQ 479, 484 (1966) ("This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness."); 2 Rosenberg, P. D., Patent Law Fundamentals, §9.04 at 9-45 (2d Ed., 1993 rev.) ("Where the claimed structure is simple and/or differs slightly from the prior art, the inquiry may focus upon the utility or result effected.") Consideration of "the utility or result effected" and whether the "utility" or "result" is

analogous to that which the prior art is directed, can and, it would seem, must include consideration of the entire disclosure of an applicant's invention. See, especially, In re Chu, 66 F.3d 292, 36 USPQ2d 1089, 1095 (Fed. Cir. 1995), citing, In re Gal, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) ("finding of 'obvious design choice' precluded where the claimed structure and function it performs are different from the prior art"; emphasis added).

Contrary to the view held by many Examiners in the PTO, it is not true that "function" and "intended use" are entitled to "no patentable weight" when evaluating the patentability of an article or apparatus claim as to the question of obviousness. Quite the opposite! Functionality and utility are vital considerations in rendering obviousness determinations and it is submitted to be difficult, if not impossible, to assess functionality and utility without a full evaluation of an applicant's disclosure, notwithstanding that the patentability examination is that of the claims. Only by a full evaluation of an applicant's disclosure is the scope of the claimed invention attainable and, thus, the scope of analogous and non-analogous prior art.

Appellant therefore respectfully maintains that an article for opening the sides of envelopes is not reasonably related, or analogous, to cutting sheets of paper or other flat material, a contention which the Examiner is unable to

logically and legally refute.

Previously, the Examiner's contended that various arguments are more relevant to rejections issued under 35 U.S.C. §112, first paragraph, rather than obviousness (third Office Action, dated July 11, 2001, at 8), is not understood and, in any event, the Examiner is mistaken in his view that "the issue at bar is not in the technical details of the invention nor is it the intended use of the invention per se." The technical details of Appellant's invention is a valid issue, and its intended use, in the context of the law of obviousness, is extremely relevant in defining the relevant technical field and those fields reasonably analogous thereto. Whether or not some of the same issues might also pertain to the law under 35 U.S.C. §112, first paragraph, is an interesting academic issue, but not of relevance to the validity of Appellant's arguments, or the Examiner's analysis, one way or the other. The Examiner was unable to provide a legal rebuttal to the foregoing argument in the final Office Action, dated March 26, 2002.

In view of the limitation in Claims 20-24 that the unit of the present invention is "freely movable" and, therefore, capable of cutting in both linear and non-linear paths, which is submitted to be clearly precluded by the devices of the applied prior art references, Appellant respectfully submits that the Board should reverse the issued 35 U.S.C. §103(a)

obviousness rejection, which applies Li, taken in view of Campbell, Jr.

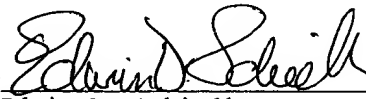
IX. Summary

In summation, it is respectfully contended that all claims now pending in the above-identified patent application (i.e., Claims 20-24) recite a novel and efficient apparatus for cutting sheet material, which is freely movable in both linear and non-linear paths, which is patentably distinguishable over the prior art.

Accordingly, reversal of the Examiner's final rejection, pursuant to 35 U.S.C. §§102(b) and 103(a), and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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Enc.: Appendix - Claims on Appeal.

The Commissioner is hereby authorized to charge the Deposit Account of Appellant's Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.

APPENDIX: CLAIMS ON APPEAL

(37 C.F.R. §1.192(c)(9))

[Claims 1-19 - Cancelled]

20. Apparatus for cutting sheet material, comprising:
a unit freely movable in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;

an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material;

a cutting blade secured in said upper and lower parts, and extending across said gap, said sheet support surface and said upper surface extending to either side of said cutting blade; and,

pressure means mounted on said upper part in said gap for bearing on the piece of sheet material supported by said lower part adjacent to said cutting blade, so that the piece of sheet material is able to be inserted between said pressure means and said sheet support surface for tensioning the piece of sheet material in proximity of said cutting blade.

21. The apparatus for cutting sheet material according to Claim 20, further comprising a holder for said cutting blade between said upper part and said lower part.

22. The apparatus for cutting sheet material according to Claim 20, wherein said pressure means comprises a freely rotatable wheel, positioned immediately in front of said cutting blade.

23. The apparatus for cutting sheet material according to Claim 20, wherein an upper face of said lower part and a lower face of said upper part are shaped for providing matching sinusoidal surfaces for supporting said upper part and for tensioning said sheet material.

24. The apparatus for cutting sheet material according to Claim 20, further comprising a window provided in said upper part for viewing said sheet material when said sheet material is immediately in front of said cutting blade.